

REMARKS

This Amendment is submitted in response to the Office Action dated October 27, 2009, having a shortened statutory period set to expire January 27, 2010. Applicant has incorporated the subject matter of claim 3 into claim 1 and has canceled claims 21, 22, 78-83, and 172-175 without prejudice or disclaimer to the subject matter recited therein. Applicant has added new claims 178-187. Claims 1, 2, 4-20, 23-69, 84-171, and 176-187 are pending. Reconsideration of the present case is earnestly requested in light of the following remarks.

I. Provisional Double Patenting Rejections

Claims 1-69 and 78-177 were provisionally rejected on the ground of nonstatutory obvious-type double patenting as being unpatentable over various claims of copending Application Ser. No. 11/391,631. Applicant believes that no action is required at this time, since the Examiner states: "This is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented." (emphasis in original).

II. Claim Rejections Under 35 U.S.C. § 112

Claims 43-62 were rejected under 35 U.S.C § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Examiner states:

There is no support for "transmitting information to the computing device through the connection;" wherein the connection was established between the computing device and the access point in the specification. The limitation requires the established connection to be bidirectional and open for the whole information transferring session, which is not supported by the specification. Therefore, the phrase "through the connection" will be interpreted as "through the first access point."

Applicant has amended claim 43 to more clearly recite the subject matter described by claim 43. Claim 43 recites, *inter alia*:

*establishing a wireless communication link between the computing device
operated by the user and the first access point;*

determining the geographic location of the computing device;
providing the geographic location of the computing device to an
information provider; and
transmitting information to the computing device via the wireless
communication link, wherein a content of the information is dependent upon the
geographic location of the computing device.

Furthermore, Applicant respectfully points out that Applicant's Specification includes "Typically, access point 10 and mobile unit 5 communicate in a wireless manner. Thus, mobile unit 5 and access point 10 would be equipped with an appropriate transmitter and receiver compatible in power and frequency range to establish such a wireless communication link." (Applicant's Specification: p. 5, line 34 – p. 6, line 4), "As illustrated in Figure 2 a first step according to the invention is establishing a connection between a mobile unit and an access point." (Applicant's Specification: p. 6, lines 24-26), "[] the communication between the mobile unit 5 and the access point 10 begins. The communication between mobile unit 5 and access point 10 may include sending and receiving information which may include text, voice data and video data." (Applicant's Specification: p. 6, lines 21-23), and "AP 10 forwards this request for information to the network 15. Network 15 routes the request to a service and information provider who obtains the requested information transmits it back to mobile unit 5 through AP 10." (Applicant's Specification: p. 13, lines 4-8). Applicant respectfully submits that at least these portions of Applicant's Specification are sufficient for at least claim 43 to comply with at least 35 U.S.C § 112, first paragraph. Accordingly, Applicant submits that claim 43 and those dependent therefrom are allowable for at least the reason(s) provided.

III. Claim Rejections Under 35 U.S.C. § 103

A. *Singer et al.* does not describe each claimed feature

Claims 43, 46, 50, 54, 55, 59, 60-63, 84, 170, 171, 176, and 177 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Singer et al.* (U.S. Patent No. 5,485,163, hereinafter "*Singer*").

1. Claims 11, 23, 92, and 178

Claim 11 recites, *inter alia*:

receive, via a first access point of the one or more access points, a geographic location of the first access point from a computing device operated by a user and communicatively coupled to the first access point; and
transmit information to the computing device, wherein a content of the information is dependent upon the geographic location of the first access point received from the computing device.

Applicant respectfully submits that *Singer* does not describe or render obvious these features. Furthermore, *Singer* does not provide "a finding that the prior art included each element claimed". Applicant respectfully points out that "[t]o reject a claim based on this rationale [Combining Prior Art Elements], Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following: [] (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;. . ." *MPEP* § 2143(A).

In contradistinction to receiving, via a first access point of the one or more access points, a geographic location of the first access point from a computing device operated by a user, *Singer* describes that PLU 4 transmits identification information and that the identification "information is forwarded, along with the node identification number (NIN) of receiving BTS 20, to the VLR 26 via BSC 30. VLR 26 translates the NIN, or other received location identifying information from BTS 20 via a lookup table to determine the approximate geographic location of PLU 4." (*Singer*: col. 4, lines 24-30).

Thus, Applicant respectfully submits that claim 11 is nonobvious and allowable for at least the reason(s) provided. Further, claims 23, 82, and 178 include features similar to claim 11, and so the arguments presented above apply equally to claims 23, 82, and 178, as well. Applicant respectfully submits that for at least the reason(s) presented above, claims 23, 82, and 178 are nonobvious and allowable. Applicant points out that "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." *MPEP* § 2143.03. Applicant respectfully submits that

claims 11, 23, 82, and 178 have been shown to be nonobvious and allowable, and thus, Applicant submits that claims respectively depending from those claims are also nonobvious and allowable for at least the reason(s) provided.

2. Claims 63 and 43

Claim 63 recites, *inter alia*:

receiving information from the information provider, wherein the information is dependent upon the geographic location of the at least one of the one or more access points and a content of the information is associated with a business; and

transmitting the information to the computing device through the at least one of the one or more access points.

Applicant respectfully submits that *Singer* does not describe or render obvious these features. Furthermore, *Singer* does not provide "a finding that the prior art included each element claimed". *MPEP* § 2143(A). In one example, "business" appears nowhere in *Singer*.

Thus, Applicant respectfully submits that claim 63 is nonobvious and allowable for at least the reason(s) provided. Further, claim 43 includes features similar to claim 63, and so the arguments presented above apply equally to claim 43, as well. Applicant respectfully submits that for at least the reason(s) presented above, claim 43 is nonobvious and allowable. Applicant respectfully submits that claims 43 and 63 have been shown to be nonobvious and allowable, and thus, Applicant submits that claims respectively depending from those claims are also nonobvious and allowable for at least the reason(s) provided. *See MPEP* § 2143.03.

3. Claims 25, 30, 33, 36, 84, 101, 111, 127, 139, 163, 169, and 186

The Examiner states:

Claim 36 is rejected for the same rationale as in claim 46, further: . . .transmitting the second information to the second computing device (*Singer*, each device has a distinct ID (*Singer*, col. 3 lines 1-5, device identifier) that can be used to identify associated user of the device; and wherein *Singer*'s method/system supports

multiple different user subscriber device/PLU pairs using PINs and device IDs (fig. 2))

Applicant respectfully submits that if the Examiner's suggestion of combining *Singer's* PLU 4 and mobile unit 6 was assumed, which Applicant believes is not proper, then a first mobile unit 6/PLU 4 combination in a coverage area 16 of BTS 20 would produce the location of BTS 20 and a second mobile unit 6/PLU 4 combination in the coverage area 16 of BTS 20 would also produce the location of BTS 20. Accordingly, the first mobile unit 6/PLU 4 combination in the coverage area 16 of BTS 20 would produce the same geographic-based information as the second mobile unit 6/PLU 4 combination in the coverage area 16 of BTS 20. Thus, Applicant respectfully submits that the Examiner's suggestion of combining PLU 4 and mobile unit 6 does not permit first information, selected based on a geographic location, to be different than second information, selected based on the same geographic location.

In contrast, claim 36 recites, *inter alia*:

receiving a geographic location of an access point communicating with a first computing device;

receiving first identification information indicating a first user of the first computing device;

receiving the geographic location of the access point communicating with a second computing device, wherein the second computing device is different from the first computing device;

receiving second identification information indicating a second user of the second computing device, wherein the second identification is different from the first identification information, wherein the second user is different from the first user;

selecting first information dependent upon the geographic location of the access point and the first identification information, wherein at least a first content of the first information is capable of being displayed by the first computing device;

transmitting the first information to the first computing device;

selecting second information dependent upon the geographic location the access point and the second identification information, wherein at least a second

content of the second information is capable of being displayed by the second computing device, wherein the second information is different from the first information; and

transmitting the second information to the second computing device.

Applicant respectfully submits that *Singer* nowhere describes or renders obvious these features. Furthermore, Applicant submits that there has not been "a finding that the prior art included each element claimed". *MPEP* § 2143(A). Further, claims 25, 30, 33, 84, 101, 111, 127, 139, 163, 169, and 186 include features similar to claim 36, and so the arguments presented above apply equally to claims 25, 30, 33, 84, 101, 111, 127, 139, 163, 169, and 186, as well. In one specific example, claim 186 recites, *inter alia*:

determining a geographic location of an access point;

transmitting first information to a first computing device communicating with the access point, wherein a first content of the information is dependent upon the geographic location of the access point; and

transmitting second information to a second computing device communicating with the access point, wherein a second content of the information is dependent upon the geographic location of the access point and is different than the first content, wherein the second computing device is different than the first computing device.

Applicant respectfully submits that *Singer* nowhere describes or renders obvious these features. Applicant submits that for at least the reason(s) presented above, claims 25, 30, 33, 36, 84, 101, 111, 127, 139, 163, 169, and 186 are nonobvious and allowable. Applicant submits that claims 25, 30, 33, 36, 84, 101, 111, 127, 139, 163, 169, and 186 have been shown to be nonobvious and allowable, and thus, Applicant submits that claims respectively depending from those claims are also nonobvious and allowable for at least the reason(s) provided. *See MPEP* § 2143.03.

4. Claim 1

Claim 1 recites, *inter alia*:

determining a geographic location of a computing device coupled to a network via an access point;

receiving identification information indicating a user of the computing device; and

transmitting, via the network and access point, information to the computing device, wherein a content of the information is dependent upon the geographic location of the computing device and demographic information of the user of the computing device associated with the identification information.

(emphasis added).

Applicant respectfully submits that *Singer* nowhere describes or renders obvious these features. Furthermore, Applicant submits that there has not been "a finding that the prior art included each element claimed". *MPEP* § 2143(A). Thus, Applicant respectfully submits that claim 1 is nonobvious and allowable for at least the reason(s) provided. Moreover, Applicant submits that claims depending from claim 1 are also nonobvious and allowable for at least the reason(s) provided. *See MPEP* § 2143.03.

B. *Singer* is not sufficient for *prima facie* obviousness

1. Change of the principle of operation of the prior art being modified

The Examiner stated, "For claim 63, *Singer* discloses. . . *Singer* does not disclose that the two devices are one. [] However, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of *Singer* to incorporate the two devices in order to provide location services to the PLU wearer with a single device and to make devices less cumbersome." (emphasis added).

Applicant respectfully submits that modifying, as the Examiner suggests, the portable locator unit (PLU) 4 by combining it with the separate and distinct mobile unit 6 "would change the principle of operation" described by *Singer*. *See MPEP* § 2143.01(VI). Applicant points out that *Singer* describes the principle of operation of providing a remote location of PLU 4 to the separate and distinct mobile unit 6 so that a user of mobile unit 6 can be directed to and find the remote location of PLU 4. For example, *Singer* provides a brief summary that indicates the

principle of operation of providing a remote location of PLU 4 to the separate and distinct mobile unit 6: "After having determined the location of the PLU [4] from the received information, the network location processor forwards this information to a designated source, such as the requesting subscriber [mobile unit 6] or other authorized user." (*Singer*: col. 2, lines 6-9). *Singer* provides additional details in col. 3, line 61 – col. 4, line 47. Applicant submits that combining PLU 4 and mobile unit 6, as the Examiner suggests, would not allow providing a remote location of PLU 4 to mobile unit 6 so that a user of mobile unit 6 can be directed to and find the remote location of PLU 4, since the PLU 4 and mobile unit 6 are in the same location. The combination of PLU 4 and mobile unit 6 would change the principle of operation described by *Singer* by rendering the function irrelevant to the mobile device. Consequently, Applicant submits that the proposed modification of *Singer* is improper for purposes of making a rejection under 35 U.S.C. §103 because it changes the principle of operation of *Singer*. (See, e.g., MPEP § 2143.01(VI), "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) [].") Thus, Applicant respectfully submits that a *prima facie* case of obvious has not been established to reject claims 1, 2, 4-20, 23-69, 84-171, and 176-187. Accordingly, claims 1, 2, 4-20, 23-69, 84-171, and 176-187 are nonobvious and allowable for at least the reason(s) provided.

2. Proposed modification of *Singer* teaches away from such modification

As discussed above, *Singer* describes providing a remote location of PLU 4 to the separate and distinct mobile unit 6 so that a user of mobile unit 6 can be directed to and find the remote location of PLU 4. Thus, combining PLU 4 with the separate and distinct mobile unit 6, would no longer permit mobile unit 6 to be directed to a remote location of PLU 4. Accordingly, the Examiner's modification of combining mobile unit 6 and PLU 4 "would be rendered inoperable for its [their] intended purpose[s]", and "[i]n effect, [] teaches away from the board's [Examiner's] proposed modification." *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Applicant respectfully points out that "[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997) []."

MPEP § 2144.05(III). Thus, Applicant respectfully submits that a *prima facie* case of obvious has not been established to reject claims 1, 2, 4-20, 23-69, 84-171, and 176-187. Accordingly, claims 1, 2, 4-20, 23-69, 84-171, and 176-187 are nonobvious and allowable for at least the reason(s) provided.

3. No support for a legal conclusion of obviousness

The Examiner stated, "For claim 63, Singer discloses. . .Singer does not disclose that the two devices are one. [] However, it would have been obvious for one skilled in the art at the time of the invention to modify the teachings of Singer to incorporate the two devices in order to provide location services to the PLU wearer with a single device and to make devices less cumbersome." (emphasis added).

Applicant respectfully disagrees and submits that modifying the portable locator unit (PLU) 4 with the mobile unit 6 described by *Singer* would make PLU 4 more cumbersome. *Singer* describes that PLU 4 "has the form of a tag, an ornamental bracelet, or the like." (*Singer*: col. 2, line 33). *Singer* further describes that PLU 4 "with appropriate miniaturization it could be incorporated in almost any object, such as a belt, watch, earring, etc." (*Singer*: col. 2, lines 36-37) (emphasis added). *Singer* also describes mobile unit 6 as a pager with an alphanumeric display or a cellular telephone. "Where mobile unit 6 is an alphanumeric pager, the information can be displayed upon a pager display. On the other hand, where mobile unit 6 is a cellular telephone, the information can be forwarded in a voice format." (*Singer*: col. 4, lines 39-42). Thus, combining mobile unit 6 and PLU 4, as the Examiner suggests, would not permit PLU 4 to be miniaturized to be apparel such as an ornamental bracelet, a watch, an earring, etc.

Therefore, the Examiner's modification voids and/or nullifies the Examiner's stated objective reason to combine the teachings of the reference. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)." *MPEP* § 2143.01(IV). Thus, Applicant respectfully submits that a *prima facie* case of obvious has not been established to reject claims 1, 2, 4-20, 23-69, 84-171, and 176-187. Accordingly, claims 1, 2, 4-20, 23-69, 84-171, and 176-187 are nonobvious and allowable for at least the reason(s) provided.

4. No suggestion or motivation to make the proposed modification

Singer teaches away from combining PLU 4 and mobile unit 6, since this combination would make PLU 4 more cumbersome. *Singer* describes that PLU 4 "has the form of a tag, an ornamental bracelet, or the like." (*Singer*: col. 2, line 33). *Singer* further describes that PLU 4 "with appropriate miniaturization it could be incorporated in almost any object, such as a belt, watch, earring, etc." (*Singer*: col. 2, lines 36-37) (emphasis added). *Singer* also describes mobile unit 6 as a pager with an alphanumeric display or a cellular telephone. "Where mobile unit 6 is an alphanumeric pager, the information can be displayed upon a pager display. On the other hand, where mobile unit 6 is a cellular telephone, the information can be forwarded in a voice format." (*Singer*: col. 4, lines 39-42). Thus, combining mobile unit 6 and PLU 4, as the Examiner suggests, would not permit PLU 4 to be miniaturized to be apparel such as an ornamental bracelet, a watch, an earring, etc. Applicant respectfully submits that combining mobile unit 6 and PLU 4, as the Examiner suggests, would render the prior art invention being modified unsatisfactory for its intended purpose, in this case, to remain miniaturized apparel and therefore be less noticeable and more likely to remain on the person of the wearer. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) []." *MPEP* § 2143.01(V).

C. Combination of *Singer* and *Muffat et al.*

Claims 44, 45, 47-49, and 51-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Singer* in view of *Muffat et al.* ("European Cooperation on Dual Mode Route Guidance-Perspectives for Advanced Research Partners", hereinafter "*Muffat*"). This rejection is respectfully traversed.

Applicant respectfully submits that *Singer* and *Muffat* cannot be combined, since *Singer* teaches away from a combination with *Muffat*. Applicant points out that *Singer* teaches away from on-board devices of automobiles (e.g., cars, trucks, etc.). See *Singer* col. 1, lines 29-46 which includes *Singer's* reference to U.S. Pat. No. 5,218,367 that describes on-board devices and their services of automobiles. *Singer* states such devices and their services associated with on-board devices of automobiles would "add undesirable bulk", such as a "car battery" or even an entire car. (*Singer*: col. 1, lines 44-45 and 34).

Accordingly, Applicant respectfully submits that *Singer* teaches away from a combination with *Muffat*. "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) []." *MPEP* § 2145 (X)(D)(2). Thus, Applicant respectfully submits that a *prima facie* case of obvious has not been established to reject claims 1, 2, 4-20, 23-69, 84-171, and 176-187 by a combination of *Singer* and *Muffat*. Accordingly, claims 1, 2, 4-20, 23-69, 84-171, and 176-187 are nonobvious and allowable for at least the reason(s) provided.

D. Various dependent claims

"If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." *MPEP* § 2143.03. Applicant respectfully submits that the pending independent claims have been shown to be nonobvious and allowable, and thus, Applicant submits that claims depending from the pending independent claims are also nonobvious and allowable for at least the reason(s) provided.

IV. Conclusion

Having now responded to each rejection set forth in the present Office Action, Applicant believes all pending claims are now in condition for allowance and respectfully request such allowance. Applicant invites the Examiner to contact the undersigned at the below listed telephone number if a telephone conference would expedite prosecution of this application.

Respectfully submitted,

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